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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Knut Adams

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EXAMINER

MANCHO, RONNIE M

ART UNIT

PAPER NUMBER

3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/937,708

Applicant(s)

KNUT ADAMS ET AL

Examiner

Ronnie Mancho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-25, 27-30, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-25, 27-30, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remark

1. Applicant has cancelled claim 31 in the amendment submitted 8-21-06. Claim 33 depends on cancelled claim 31. So claim 33 should also be cancelled. On the other hand, it seems as the applicant inadvertently omitted the proper dependency of claim 33. Thus the examiner will assume that claim 33 depends from claim 32. If the applicant is not in agreement with the changes, then applicant would need to amend the claims to correct the dependency of claim 33.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-25, 27-30, 32, 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 16, the applicant recites, "short term monitoring of". It is not clear what all is meant and encompassed by the phrase "short term" in the claimed "short term monitoring of". The phrase is indefinite.

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In claim 32, the applicant recites “wherein the control signals issued by said control and monitoring system relate to at least *one of powering and movement* of the device. It can be understood that applicant’s invention (sec. 0023) has a GPS unit that monitors the movement of the device or vehicle. On the other hand, there was no disclosure that the control signals issued by said control and monitoring system relate to *powering* of the device or vehicle. In the last few lines of applicant’s specification, section 0026 recites “The corresponding rules DR for this short-term monitoring are thus chosen such that the recording of the data signals by means of the recording unit DA takes place only in a (Generator of the supply voltage source in the vehicle in operation) operating mode, or only in an (ignition ON) operating mode. This ensures that the battery voltage of the vehicle in which the data acquisition apparatus MC is arranged is not loaded unnecessarily”. Therefore, applicant’s disclosure indicates that data is recorded or acquired when a supply voltage of a generator is on, or when a vehicle ignition is on. Thus there is no disclosure that the control signals issued by said control and monitoring system relate to *powering* of the device or vehicle as claimed.

In claim 33, the applicant claims “power train”. Nowhere in the disclosure is the claimed “Power train” recited. Power train could imply a transmission, a battery of hybrid vehicle, etc,

The rest of the claims are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 16-25, 27-30, 32, 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Westerlage et al (6295449)

Regarding claim 16, Westerlage et al (figs. 5-12) disclose an apparatus (216, figs. 5&7) for acquiring data from a device (vehicle 212, figs. 5-8; col. 22, lines 25-41), the apparatus (216, figs. 5&7) mounted on the device (vehicle 212, col. 14, lines 14-17) for transmission of the acquired data to a control center (226, 228, 224; fig. 5), the apparatus (216) comprising:

a control and monitoring system (system 244, 246, 256, 258, 259, fig. 7; col. 22, lines 31-60) directly controlling (delivery or destination instructions; col. 18, lines 8-18; i.e. central host thru apparatus 216 coordinates activities of vehicles or trucks, col. 20, lines 49-52) operational states (col. 16, lines 62-67; col. 18, lines 1-18) of the device (vehicle 212; col. 22, lines 31-36, lines 57-60) of the device (vehicle 212; col. 14, lines 14-17) on which said apparatus 216 is mounted, via control signals (i.e. sensors of apparatus 216 are connected to the vehicle 212 via signals to collect performance data of vehicle 212, col. 16, lines 62-67),

at least one input interface (240, 266, 272-276, etc; fig. 7) for supplying input signals;

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a transmitting/receiving unit 238 (fig. 7);

a signal processing apparatus 246 (col. 16, lines 25-45) coupled to the input interface (240, 266, 272-276, etc; fig. 7) for signal processing of the input signals to derive output data in accordance with a first set of predetermined rules, said signal processing unit 246 including a data analysis unit to record (col. 16, lines 25-45) selected input signals at predetermined times in accordance with recording rules defined in advance by the control center (226, 228, 224; figs. 5, 8, col. 16, lines 20-38) for short-term monitoring of information derived from the input signals; and

an output interface 216 (col. 7, lines 53-65; col. 16, lines 25-45), coupled to the signal processing unit 246, for supplying the output data (see wireless link, figs. 5-7) from said signal processing unit 246 to said transmitting/receiving unit 218 (figs. 5&6) for at least one of automatic transmission or transmission initiated on request.

Regarding claim 17, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, further comprising at least one writeable memory for storage of an operating system for the apparatus and the recording rules remotely loaded via the transmitting/receiving unit.

Regarding claim 18, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, characterized in that the apparatus has a data converter, which is arranged between the input interface and the signal processing unit and which is used for removing distortion from the supplied input signals and for providing a standard data format for the input signals.

Regarding claim 19, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 18, characterized in that the apparatus has an address allocation unit, which is provided

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between the data converter and the input interface, and is intended for conversion of a source-specific addresses of the input signals to the address format of the data converter.

Regarding claim 20, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the apparatus is installed in a mobile vehicle which is operated by a motor or engine, and has a generator of a supply voltage, and

wherein the apparatus further comprises:

a power supply connection (figs. 1&7) coupled to the generator of the supply voltage in the vehicle, said transmitting/receiving unit and said signal processing unit; and

a detection unit, coupled to said power supply connection and to said data analysis unit, to detect at least whether the generator of the supply voltage source is in operation, and to interrupt said data analysis unit when the generator of the supply voltage source is not in operation.

Regarding claim 21, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 20 further comprising a memory, coupled to the signal processing unit, to store a second set of predetermined rules, and wherein said signal processing unit further comprises a data processing unit to record information data derived from the input signals in accordance with the second set of predetermined rules.

Regarding claim 22 (as best understood), Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, wherein said memory further comprises a first memory area containing predetermined rules for keeping the supply voltage source in operating mode, and a second memory area containing predetermined rules for not keeping the supply voltage source in operating mode.

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Regarding claim 23, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, wherein the signal processing apparatus has an alarm unit, coupled to said memory and to said data processing unit, for monitoring information data derived from the input signals in accordance with predetermined alarm rules, and wherein the apparatus further comprises a memory to store predetermined rules for the alarm unit.

Regarding claim 24, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 23, characterized in that the apparatus has an alarm archive for storing information on alarms that have occurred.

Regarding claim 25 Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, characterized in that the signal processing unit includes a monitoring unit, coupled to said at least one input interface, for monitoring of the input signals and the information data.

Regarding claim 27, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16 further comprising a GPS interface to connect the apparatus to a GPS receiver.

Regarding claim 28, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the input signals are operating data relating to one of a vehicle and a machine.

Regarding claim 29, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 28; characterized in that the apparatus is integrated in a car radio receiver and in a car radio receiver/mobile telephone appliance.

Regarding claim 30, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein said transmitting/receiving unit transmits the output data to at least one of the control center and a predetermined receiver.

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Regarding claim 32, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the control signals issued by said control and monitoring system relate to at least one of powering and movement (col. 8, lines 18-29; col. 17, lines 51-63) of the device (vehicle, fig. 5) in which said apparatus is mounted.

Regarding claim 33, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 32, wherein the device is a vehicle (figs. 5, etc) having a powertrain, and wherein the output data includes conditions of the powertrain (see diagnostics of subsystem, col. 7, lines 9-12; col. 8, lines 18-29; col. 17, lines 51-63; col. 20, lines 29- 40).

MPEP 2114

6. The statements of intended use or field of use, “directly controlling operational states”, “to perform signal processing of.....in accordance with a first set of predetermined rules”, “to record selected signals at predetermined times..... in accordance with recording rules defined in advance by”, “for short term monitoring of information derived from”, “to supply the output data from.....for at least one of automatic transmission.....initiated on request”, etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

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A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

7. Applicant's arguments filed 8-21-06 have been fully considered but they are not all persuasive.

The applicant is arguing that in the prior art, the limitations rejected with respect to claim 32 could be found in applicant's disclosure and further that it is well known in the art to have such a limitation in the vehicle. The examiner disagrees. There is no disclosure of “powering of the device” as claimed. It is true as known in the art that controlling operating modes can include applying brakes, cruise control, navigation control. On the other hand, the applicant has not admitted that the limitation, “the control signals issued by said control and monitoring system relate to at least *one of powering and movement* of the device.” Is known in the art.

It is also noted that claim 33 depends on a cancelled claim. Applicant is advised to particularly claim the invention. That is the applicant argues that a power train is well known in

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the art. It is noted that a powertrain is well known in the art. On the other hand, the applicant did not admit that the limitation, "the output data includes conditions of the powertrain" is well known in the art.

Applicant has repeatedly argued that Westerlage et al do not disclose "a control and monitoring system" as claimed and further that the Westerlage does not anticipate the invention.

In response, the argument is traversed. Westerlage et al disclose a control and monitoring system (system 244, 246, 256, 258, 259, fig. 7; col. 22, lines 31-60) directly controlling (delivery or destination instructions; col. 18, lines 8-18; i.e. central host thru apparatus 216 coordinates activities of vehicles or trucks, col. 20, lines 49-52) operational states (col. 16, lines 62-67; col. 18, lines 1-18) of a the device (vehicle 212; col. 22, lines 31-36, lines 57-60), wherein the apparatus 216 is mounted on the device (vehicle 212; col. 14, lines 14-17) via control signals (i.e. sensors of apparatus 216 are connected to the vehicle 212 via signals to collect performance data of vehicle 212, col. 16, lines 62-67). Therefore, the prior art anticipates the claims.

The rejection is believed to be proper and stands

Communication

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

1/8/07


JACK KEITH
SUPERVISORY PATENT EXAMINER